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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,335	02/14/2002	Yvonne Watters Booth	AUS920010775US1	1983
45502	7590	10/05/2005		EXAMINER
DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN, TX 78759			APPIAH, CHARLES NANA	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/076,335	BOOTH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Charles N. Appiah	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 15 July 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-5,7-9,11,12 and 21-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,7-9,11,12,21 and 23-27 is/are rejected.
- 7) Claim(s) 22 and 28 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-5, 7-9, 11, 12, and 21-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 7-9, 11, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Grube et al. (5,638,423).

Regarding claims 1, 9 and 24 Grube discloses a method, a system for determining an electronic device within a wide area network, and a machine readable medium having a plurality of instructions when executed cause the machine to perform a method for determining a position of an electronic device within a wide area network, the method comprising: distributing a tracing tool to a first network element within the wide area network (provision of proximity user card with the communication unit, see col. 1, lines 55-57), detecting a physical separation of the electronic device and an associated user (message being sent to the central controller when the distance between the proximity card and the communication unit exceeds a predetermined value, col. 1, lines 59-64), determining identifying indicia of the electronic device, wherein the identifying indicia are automatically transmitted the electronic device during

communication between the electronic device and a second network element of the wide area network (proximity card transmitting user identification over a second RF communication path to the communication unit, col. 1, lines 57-59), monitoring traffic on the wide area network utilizing the tracing tool wherein the monitoring comprises intercepting of the communication between the electronic device and the second network element including the identifying indicia in response to the physical separation (proximity message being set when a response is not received from proximity card and sent to central controller, see col. 3, lines 26-48), and determining a physical position of the electronic device within the wide area network in response to an interception of the identifying indicia central controller determining the location of the communication unit, such that the unit may be reclaimed and the person in possession apprehended, see col. 3, lines 48-54).

Regarding claims 3, 11 and 26, Grube further discloses wherein determining the identifying indicia of the electronic device comprises: identifying data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network, and by extracting the identifying indicia from data transmitted by the electronic device prior to the physical separation (see col. 2, lines 39-55).

Regarding claim 7, Grube further discloses the method comprises causing data specifying the identifying indicia to be stored within a database associated with the first network element prior to the physical separation (see col. 2, lines 12-27), and determining the identifying indicia of the electronic device comprises determining the identifying indicia utilizing the database (see col. 2, line 62 to col. 3, line 10).

Regarding claim 8, Grube further discloses generating a notification indicating the physical position of the electronic device for a responsible party associated with the electronic device (system manager being informed by central controller of the proximity message, col. 3, lines 38-45).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 5, 12, 21, 23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grube et al. as applied to claims 1, 9 and 24 above, and further in view of Cotichini et al. (6,300,863).

Regarding claims 2, 21, 23 and 25, Grube fails to explicitly teach the distributing further comprises distributing the tracing tool to a plurality of network elements within the wide area network the elements being a plurality of IP routers within the wide area network and the monitoring server is distributed among a plurality of network elements within the wide area network.

Cotichini discloses a method for monitoring and locating an electronic device over a global network in which IP routers and a monitoring server are used in monitoring for lost, stolen or missing electronic devices (see Fig. 1, col. 8, lines 12 and col. 16, lines 65).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Grube, unauthorized access prevention system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

Regarding claims 4, 12, and 27, Grube fails to explicitly teach wherein determining the identifying indicia of the electronic device comprises determining a MAC address of the electronic device.

In an analogous field of endeavor, Cotichini discloses a method for monitoring and locating an electronic device over a global network in which the indicia which is the MAC address of the electronic device is used in identifying the electronic device (see col. 16, lines 37-42).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Grube, unauthorized access prevention system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

Regarding claim 5, Grube fails to disclose that determining the identifying indicia of the electronic device comprises determining the identifying indicia utilizing at least one of host name and an IP address within data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network.

Contichini further discloses wherein the identifying indicia is determined by utilizing host name or IP address of the electronic device contained within data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network (see col. 11, lines 51-64).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Grube, unauthorized access prevention system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

***Allowable Subject Matter***

6. Claims 22 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brockelsby et al. (5,631,642) discloses a mobile object tracking system.

Cotichini et al. 96,269,392) discloses a method for monitoring and locating electronic devices.

Levi (6,833,787) discloses a method for device tracking.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA



CHARLES APPIAH  
PRIMARY EXAMINER